UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
ZURITA, JAMES H

ART UNIT	PAPER NUMBER
3625	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 June 2009*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23, 26-28, 31-38* is/are pending in the application.

    4a) Of the above claim(s) *1-22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23, 26-28, 31-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

On 23 June 2009, applicant cancelled claims 24-25 and 29-30.

Applicant amended claims 23, 28, 31 and 33.

Claims 1-23, 26-28, 31-38 are pending, of which claims 1-22 are withdrawn from

prosecution as being directed to a non-elected invention.

Priority Date

The instant application has a priority date of 11/18/2003.

Response to Arguments

Applicant's arguments filed 06/23/2009 have been fully considered but they are

not persuasive.

Applicant argues,

> Applicants submit that a person of ordinary skill in the art would readily
> appreciate that practicable embodiments of the claimed invention would be conducted
> with the aid of a computing machine, such as a **server**. Such computing machines are
> commonly understood to have **memory.** Further, the operations recited in the claims
> clearly change the state of the underlying data since the cache, register, or other memory
> on which the data is stored must be transformed to have a different magnetic polarity,
> electrical charge, or the like depending on the technology that is used. These are real
> physical changes. Further, memory is a real physical article. As such, Applicants submit
> that the method claims perform a transformation under the "machine or transformation"
> test and thus qualify as patent-eligible subject matter.

In response, the Examiner notes that the terms server, memory, cache, register

and magnetic polarity are not mentioned in method claim 33. Mere mention of

"...computer-implemented..." in the preamble of claim 33 is an Inconsequential and

trivial use of technology.

Applicant argues

Regarding Claims 33-38, it is noted that at least **_means for_** inputting commerce data involves hardware and thus the claims are not software per se.

In response, the Examiner notes that paragraph 0077 specifies:

[0077] The present invention can be realized in hardware, software, **or a** combination of hardware and software.

Applicant argues

However, Flaxer does not concern conducting an electronic commerce transaction involving two or more discrete **business entit**ies and/or business applications as does the present invention. It is noted that in Flaxer all the phases involved are within one **business entit**y...

Using these common application independent software building blocks, such as the adaptive documents and the adaptors, the present invention can achieve business process integration involving two or more discrete **business entit**ies and/or business applications.

In response, the Examiner notes that _business entities_ appears on the preamble

of his claims. As such, the language carries little to no patentable weight unless given

life in the claim limitations.

Applicant argues

Flaxer also does not disclose the concept of an adaptive document, which is a semi-autonomous software unit that encapsulates business data and can exhibit variable behavior based upon different processing states. Flaxer further does not disclose the concept of a data adaptor for converting data from one format to another format in order to reconcile data formats so that data can be exchanged between different applications, and a transport adapter for translating messages between messaging protocols used by different applications. Using these common application independent software building blocks, such as the adaptive documents and the adaptors,

Respectfully, the terms "...adaptive document ...semi-autonomous software unit

that encapsulates business data..." are not claimed. During prosecution, claims are

given their broadest reasonable interpretation:

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the

specification" without importing limitations from the specification into the claims
unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 551 (CCPA
1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir.
1989) ("During patent examination the pending claims must be interpreted as broadly as
their terms reasonably allow.... The reason is simply that during patent prosecution when
claims can be amended, ambiguities should be recognized, scope and breadth of
language explored, and clarification imposed.... An essential purpose of patent
examination is to fashion claims that are precise, clear, correct, and unambiguous. MPEP
2106.

The Examiner notes that applicant provides no definitions for the various terms.

Since appellant has provided no explicit definition for the above terms, the Examiner

relies on the term's ordinary meaning and broadest reasonable interpretation. *E-Pass*

Technologies, Inc. v. 3Com Corporation, 343 F.3d 1364, 1368, 67 USPQ2d 1947, 1949

(Fed. Cir. 2003).

...Where an explicit definition is provided by the applicant for a term, that definition will
control interpretation of the term as it is used in the claim. Toro Co. v. White
Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir.
1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum,
but in the context of the specification and drawings."). Any special meaning assigned to
a term "must be sufficiently clear in the specification that any departure from common
usage would be so understood by a person of experience in the field of the invention."
Multiform Desiccants Inc. v. Medzam Ltd., 133 F.3d 1473, 1477, 45 USPQ2d 1429,
1432 (Fed. Cir. 1998). See also MPEP § 2111.01.

Thus, the terms adaptive...data adaptor...carry little to no patentable weight

since these differences are only found in the nonfunctional descriptive material and do

not alter the functions claimed.

Claim Rejections - 35 USC § 101

The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

Method claims 23, 26-27 are directed to non-statutory subject matter. Based on

Supreme Court precedence see Diamond v Diehr 450 US 175,184 (1981); Parker v.

Flook, 437 US 584,588,n. 9 (1978); Gottschalk v Benson, 409 US 63, 70 (1972);

Cochtane v Deener, 94 US 780, 787-88 (1876) a 101 process must (1) be tied to

another statutory class (such as an apparatus) or transform underlying subject mater

(such as an article or materials) to a different state or thing. Since neither of these

requirements is met by the claim the claim is rejected as being directed to non-statutory

subject matter.

Claims 33-38 are directed to software per se; there is insufficient structure in the

disclosures.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

Claims 23, 28 and 33 "...initializing an electronic commerce ***transaction***..." that

is not further mentioned. The claims also refer to an "...electronic commerce ***action***..."

For purposes of examination, the term is interpreted to include customization of choice

of services based upon the type of transaction.

Claims 23, 28 and 33 refer to "...actions of said adaptive document are

dependent upon a state of said adaptive document..." Claims 24 and 29 refer to "...an

electronic document..." and it is not clear whether applicant is referring to a second

document. For purposes of examination, the term is interpreted to include xyz

Claims 23, 28 and 33 refer to "…applicant independent…" algorithms which are mentioned in para 0019. For purposes of examination, the term is given its broadest reasonable interpretation to include business rules.

In claims 33-38, the phrase "means for" appear to be an attempt to invoke 35 U.S.C. 112, sixth paragraph, to recite claim element as a means for performing a specified function. However, since the disclosures provide insufficient structural support for the claims, it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See Ex parte Klumb, 159 USPQ 694 (Bd. App. 1967). For purposes of this examination, the claim will be interpreted to not invoke the sixth paragraph. Prior art will be interpreted to read on applicant's claimed limitations where prior art discloses that the structure is reasonable capable of performing the recited functions.

Affidavit under 37 CFR 1.131

The Affidavit filed on 06/23/2009 under 37 CFR 1.131 has been considered but is ineffective to overcome the Flaxer reference.

The affidavit or declaration must contain an allegation that the acts relied upon to establish the date prior to the reference or activity were carried out in this country or in a NAFTA country or WTO member country. (See MPEP 715.07(c) and 35 U.S.C. 104).

The listing of references in the Affidavit is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states,

"the list may not be incorporated into the specification but must be submitted in a

separate paper." Therefore, unless the references have been cited by the examiner on

form PTO-892, they have not been considered.

The Affidavit includes a publication by Cheng, Thomas, Kumaran, Rajasekharan,

Wu, Yi and Huang, "A Model-Driven Approach for Item Synchronization an UCCnet

Integration. There is no date given for the publication.

Applicant fails to explain the relevance of a series of drawings referred to as

"Collaborative Enterprise…UCC Net."

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

Claims 22-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Flaxer

et al. (US PG-PUB 2004/0162741).

As per claim 23, Flaxer discloses computer-implemented method for conducting

an electronic commerce transaction involving two or more discrete business entities

and/or business applications comprising the steps of:

initializing an electronic commerce transaction; see, for example, para 0333.

inputting commerce data into an adaptive document, wherein actions of said

adaptive document are dependent upon a state of said adaptive document; see, for

example, para 0091

converting the commerce data from a format of the electronic document to a

format of an adaptive document using a data adaptor; XML, as in para 0155.

inputting the converted commerce data into the adaptive document, wherein

electronic commerce actions performed on the adaptive document are dependent upon

a state of said adaptive document; see references to workflow, and business rules,

para 0011.

initializing a transport adaptor to determine a messaging protocol between a

current location of the adaptive document and a destination location of the adaptive

document; see, for example, at least para 0334.

establishing a communication link between the current location of the adaptive

document and the destination location of the adaptive document; (as in para 00333,

flow manager and choice of services;

conveying said adaptive document to the destination location via the

communication link; see, for example, at least Fig. 9 and related text; and

performing at least one electronic commerce action upon said adaptive

document, wherein said electronic commerce action utilizes application independent

algorithms. See, for example, references to business rules, as in para 0011.

conveying said adaptive document to a different location; see, for example, at

least Fig. 9 and related text.

As per claim 26, Flaxer discloses altering a state of said adaptive document based upon instructions detailed within a process flow. See, for example, at least Fig. 5 and related text concerning state. See also para 0088, for example.

As per claim 27, Flaxer discloses after said performing step, conveying said adaptive document to another location; see, for example, at least para 0143 converting data within said adaptive document from a format of said adaptive document to a format of an electronic document; *and* presenting at least a portion of said electronic document containing said converted data within an application of said another location. See, for example, at least para 0293.

Claim 28 is rejected on the same grounds as claim 23.

Claim 31 is rejected on the same grounds as claim 26.

Claim 32 is rejected on the same grounds as claim 27.

Claim 33 is rejected on the same grounds as claim 23.

As per claim 34, Flaxer discloses that the adaptive document can be conveyed among a plurality of defined states, and wherein functionality of said adaptive document is dependant upon a state within which said adaptive document is disposed. See, for example, at least para 0088.

As per claim 35, Flaxer discloses that the adaptive document can be conveyed from one defined state to another defined state in response to an occurrence of a system event. See, for example, at least para 0093.

As per claim 36, Flaxer discloses that messaging protocols are adapted to facilitate a conveyance of the adaptive document across a network. See, for example,

Figs. 18-20, which show messaging across a network, which "... facilitate a conveyance

of the adaptive document across a network..."

As per claim 37, Flazer discloses that data is mapped from one data structure to

another data structure. See, for example, at least references to XML, as in para 0155.

As per claim 38, Flaxer discloses that interactions are modeled within interfaces

associated with the electronic commerce transaction. See, for example para 0295.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES ZURITA whose telephone number is (571)272-6766. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Zurita/
James Zurita
Primary Examiner
Art Unit 3625
25 October 2009